REMARKS

Claims 1-19 are rejected under 35 U.S.C. §102(b) as being anticipated by *Navia et al* (U.S. 5,175,669) ("*Navia*"). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

The *Navia* reference is clearly misunderstood and misapplied.

In *Navia*, member 12 is a single member injection molded of polycarbonate. Member 12 is seated on a card and tabs 18 extend through slot 38 to attach member 12 to the chassis 28.

The invention comprises two identical members 410 a, b. When interconnected, and relatively inverted (see claims 4, 5, 11, 15), the first and second members include spaced apart first portions 420 and interlocking and overlapping second portions 422.

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection *Navia* reference must contain all of the claimed elements of independent claims 1, 5, 8 and 12. However, the invention as claimed, is not shown or taught in this reference. Therefore, the rejection is unsupported by the art and should be withdrawn.

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1, 5, 8 and 12 and claims dependent therefrom are not anticipated by the cited art and are therefore submitted to be allowable.

Claims 20 and 21 are rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over *Navia*. Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102 and/or in establishing a *prima facie* case of obviousness.

Claim 20 includes: ... providing a first ribbed member in a first orientation; providing a second ribbed member, identical to the first ribbed member, in a second orientation inverted from the first orientation; attaching the first ribbed member to the second ribbed member including overlapping interlocking sections forming a continuous double-walled reinforcing member; and securing the attached ribbed members in the computer chassis.

As the PTO recognizes in MPEP § 2142:

> ... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness...

In the present case, the reference does not provide all the limitations of the claimed invention. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

> A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the Examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d I 110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

> The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy,* 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

> The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness vel non of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

Because all the limitations of claims 20 and 21 have not been met by the *Navia* patent, claims 20 and 21 are not anticipated by *Navia*, or in the alternative, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

In view of the above, it is respectfully submitted that remaining claims 1-21 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,

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